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EXAMINER

ORR, HENRY W

ART UNIT	PAPER NUMBER
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2176

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/692,257	Applicant(s) DUNN ET AL.	
	Examiner Henry Orr	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/23/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to application communication filed on 10/23/2003.
2. Claims 1-41 are pending in the case. Claims 1, 15, 22, 36, 40 and 41 are independent claims.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 10/23/2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Drawings

4. Figure 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 1-14 and 36-39 are objected to because of the following informalities:

Claim 1:

Claim 1 has a period (i.e. application.) in the middle of the sentence in line 11. Examiner suggest to applicant to replace period with a semi-colon (i.e., ";") to overcome objection.

Claim 1 recites "**actually be actually**" in line 14, which appears to be a grammatical error.

Claims 2-14:

Dependent claims 2-14 are objected for fully incorporating the deficiency of base claim 1.

Claim 36:

Claim 36 is a duplicate claim of method claim 15. Examiner suggests to applicant to change method claim 36 to a manufacture claim, according to the dependents of claim 36.

Claims 37-39:

Dependent claims 37-39 are objected for fully incorporating the deficiency of base claim 36.

Appropriate corrections are required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-14, 22-35, 37-39 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1 and 22:

Claims 1 and 22 recites the phrase “**the information**”. There is insufficient antecedent basis for this limitation in the claims because it is unclear whether “**the information**” is referring to previously recited “**the contact information**” in the preamble of the respective claims.

Claims 14 and 35:

Claims 14 and 35 recite the phrase “**the same entity**”. There is insufficient antecedent basis for this limitation in the claims because the phrase has not been previously recited in their respective base claims.

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Claims 37-39:

Claims 37, 38 and 39 recite the phrase "**a computer program product**". There is insufficient antecedent basis for this limitation in the claims because the phrase has not been previously recited in their respective base claims.

Claims 2-14 and 23-35:

Dependent claims 2-14 and 23-35 are rejected for fully incorporating the deficiencies of their respective base claims.

Claim 41:

As per claim 41, the phrase "**such a manner as**" in line 13 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 22-35 and 40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to abstract ideas that are not tied to a technological art, environment, or machine which would**

result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Claims considered to be Non-functional Descriptive Material are not statutory even if in combination with a physical medium. see MPEP § 2106

Claim 22:

Claim 22, recites a **“computer program product”** comprising a **“computer-readable media”**. The Specification of the instant application states that a **“computer-readable media”** includes a computer-readable medium scope of any connection such as a wireless communication connection (see p. 10 par. 29). Thus, Claim 22 fails to recite a process, a machine, a manufacture or a composition of matter.

Accordingly, the claim fails to recite statutory subject matter as defined in 35 U.S.C. § 101.

Claim 40:

Claim 40, recites a **“computer-readable media”**. The Specification of the instant application states that a **“computer-readable media”** includes a computer-readable medium scope of any connection such as a wireless communication connection (see p. 10 par. 29). Thus, Claim 22 fails to recite a process, a machine, a manufacture or a composition of matter.

Accordingly, the claim fails to recite statutory subject matter as defined in 35 U.S.C. § 101.

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Claims 23-35:

Dependent claims 23-35 are rejected for fully incorporating the deficiency of base claim 22.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. **Claims 1-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown, U.S. Published Application No. 2002/0156895 A1.**

Claim 1:

Brown teaches a user initiating an application to request for desired contact information (see par. 27, par. 32). **(claim 1; i.e., detecting a request from an application for desired contact information;)**

Brown teaches in response to the request, selecting an appropriate contact persona from one or more possible contact personas, wherein each contact persona comprises contact information (see par. 35). **(claim 1; i.e., in response to the request, selecting an appropriate contact persona from one or more possible contact personas that are available to the computing system, each contact persona**

comprising available contact information;) Examiner interprets the specific groups such as personal information and business information to be examples of the contact personas as taught by Brown (see par. 35).

Brown teaches a user identifying some of the available contact information intended to be provided to the application in response to the request and determining an appropriate format to present the identified contact information (see par. 35).

(claim 1; i.e., identifying at least some of the available contact information that is intended to be provided to the application in response to the request and determining an appropriate format in which the identified contact information will be presented to the application. presenting to the user the information that is intended to be provided to the application and allowing the user to determine whether that information will actually be actually provided to the application and whether other information will be provided to the application; and providing the identified contact information in the appropriate format to the application as designated by the user.) Examiner interprets the user to be able to control, which contact information (i.e., business or personal) is accessible by the application and for the contact information to be presented in an appropriate format (i.e., business or personal layout) as designated by the user (see par. 35).

Claim 2:

Brown teaches each of the available contact personas correspond to a single user of the computing system (see abstract). **(claim 2; i.e., wherein each of the available contact personas correspond to a single user of the computing system.)**

Claim 3:

Brown teaches selecting the appropriate contact persona occurs in response to user selection of one of the possible contact personas (see par. 35). **(claim 3; i.e., wherein selecting the appropriate contact persona occurs in response to user selection of one of the possible contact personas.)**

Claim 4:

Brown teaches presenting a listing of possible contact personas to the user for selection (see par. 35). **(claim 4; i.e., wherein a listing of the possible contact personas are presented to the user for selection.)**

Claim 5:

Brown teaches identifying available contact information to be presented to the application via user selection of the available contact information (par. 35). **(claim 5; i.e., wherein identifying at least some of the available contact information to be presented to the application occurs through user selection of the available contact information.)**

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Claim 6:

Brown teaches identifying available contact information to be presented to the application to occur automatically in response to default selections ("settings") (see par. 35). **(claim 6; i.e., wherein identifying at least some of the available contact information to be presented to the application occurs automatically in response to default settings corresponding to the appropriate contact persona.)**

Claim 7:

Brown teaches identifying contact information to be presented to the application based on determining whether the contact information will be used for business or personal use (see par. 35). **(claim 7; i.e., wherein identifying at least some of the available contact information to be presented to the application in response to the request includes determining what the contact information will be used for.)**

Claim 8:

Brown teaches determining whether the application has authorization to access the requested contact information (see par. 34, par. 39). **(claim 8; i.e., determining whether the application has authorization to access the requested contact information.)**

Claim 9:

Brown teaches upon determining the application authorization to access, the contact persona and corresponding contact information is automatically provided in the appropriate format (see par. 39-42). **(claim 9; i.e., wherein upon determining the application has authorization to access the requested contact information, the appropriate contact persona is automatically selected the identified contact information is automatically identified and provided to the application in the appropriate format.)**

Claim 10:

Brown teaches determining that the application has authorization based upon an access control list (see par. 36). **(claim 10; i.e., wherein it is determined that the application has authorization based upon one or more authorizations provided in an access control list of the computing system.)**

Claim 11:

Brown teaches the application requesting information to be capable of being hosted on a remote system communicating via Internet with the computing system (see par. 8, par. 25, par. 29, Figures 1-2). **(claim 11; i.e., wherein the application requesting information is hosted on a remote system that is in communication with the computing system through the Internet.)**

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Claim 12:

Brown teaches the application requesting the contact information to be capable of being hosted by the computing system (see par. 8, par. 25, par. 29, Figures 1-2). **(claim 12; i.e., wherein the application requesting the contact information is hosted by the computing system.)**

Claim 13:

Brown teaches contact information including a name and an address (see par. 20). **(claim 13; i.e., wherein the requested contact information includes at least one of a name and an address.)**

Claim 14:

Brown teaches a first contact persona differing from a second contact persona and for both contact personas to correspond to same person ("entity") (see par. 35). **(claim 14; i.e., wherein the available contact information corresponding to a first contact persona differs from the available contact information corresponding to a second contact persona, and even though the first and second contact personas both correspond to the same entity.)**

Claim 15:

Brown teaches providing an interface object for allowing a user to select a contact persona from a plurality of possible contact personas as recited in claim 15 (see

par. 35). **(claim 15; i.e., providing an interface object for allowing a user to select a contact persona from a plurality of possible contact personas, each contact persona corresponding to a person and respective contact information about the person, wherein the respective contact information corresponding to a first contact persona differs from the available contact information corresponding to a second contact persona, even though the first and second contact personas are both associated with the same person;)**

Brown teaches in response to a user selection of a contact persona, displaying the respective contact information corresponding to the selected contact persona (see par. 41-42). **(claim 15; i.e., in response to a user selection of a particular contact persona, displaying the respective contact information corresponding to the selected contact persona;)**

Brown teaches updating ("modify") the respective contact information as recited in claim 15 (see abstract, par. 32, par. 35, par. 41, par. 46). **(claim 15; i.e., and enabling the user to modify the respective contact information corresponding to the selected contact persona;)**

Brown teaches a user initiating an application to seek contact information from the computing system, and providing the respective contact information corresponding to the selected contact persona (see par. 27, par. 32, par. 35). **(claim 15; i.e., and upon an application seeking contact information from the computing system, providing the respective contact information corresponding to the selected**

contact persona.)

Claim 16:

Brown teaches the interface object is displayed in response to a request by the application for contact information (see par. 41). **(claim 16; i.e., wherein the interface object is displayed in response to a request by the application for contact information.)**

Claim 17:

Brown teaches an approved list associated with the stored contact information (see par. 36, par. 38). **(claim 17; i.e., wherein the respective contact information is displayed with one or more privacy policies of the application that specify at least one of how and when the contact information will be used by the application.)**

Examiner interprets the approved list to include contact information of when the contact information will be used by the application (i.e., when a user on the approved list attempts to access the contact information with the application). The approved list is interpreted to be a form of a privacy policy because the approved list communicates when an application used by a user cannot access the stored contact information.

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Claims 18-20:

Claims 18, 19, and 20 are method claims and are substantially encompassed in method claims 11, 12 and 13 respectively; therefore the method claims are rejected under the same rationale as method claims 11, 12 and 13 above.

Claim 21:

Brown teaches contact personas are associated with a logged on user of the computing system (see par. 34, par. 39, par. 45). **(claim 21; i.e., wherein the contact personas are associated with a logged on user of the computing system.)**

Claims 22-35:

Claims 22-35 include a program embodied on a computer readable medium to implement the steps that are substantially encompassed in method claims 1-14 respectively; therefore the claims are rejected under the same rationale as method claims 1-14 above.

Claims 36-39:

Claims 36, 37, 38 and 39 are substantially encompassed in method claims 15, 16, 17 and 18 respectively; therefore claims 36, 37, 38 and 39 are rejected under the same rationale as method claims 15, 16, 17 and 18 above.

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Claim 40:

Claim 40 includes a program embodied on a computer readable medium to implement the steps that are substantially encompassed in method claim 1; therefore the claim is rejected under the same rationale as method claim 1 above.

Claim 41:

Claim 41 is a method claim and is substantially encompassed in method claims 1 and 14; therefore the method claim is rejected under the same rationale as method claims 1 and 14 above.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry Orr whose telephone number is (571) 270 1308.

The examiner can normally be reached on Monday thru Friday 8 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571) 272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

6/19/2007

HO

A handwritten signature in black ink, appearing to read 'Doug Hutton', is positioned above the printed name and title.

Doug Hutton
Primary Examiner
Technology Center 2100